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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,341	12/26/2001	Alexander Stenzel	LMX-88	3315

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Bernard S. Klosowski, Jr.
Dority & Manning
Attorneys at Law, P.A.
P.O. Box 1449
Greenville, SC 29602

EXAMINER

SIKDER, MOHAMMAD YUNUS

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,341

Applicant(s)

STENZEL, ALEXANDER

Examiner

MOHAMMAD Y SIKDER

Art Unit

2872

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-3, 4, 5-12, and 18-19 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the Groups II and III are not subcombination claims, and since classification for the claims of groups I, II, III as set forth in the restriction requirement is class 359, it is not "serious burden" to examine all these claims.

First, applicant has based on the argument on his own definition of what constitutes a "serious burden" and not the definition provided in the MPEP, section 803. In the restriction requirement (Paper No. 4), the examiner has demonstrated a "serious burden" by showing a separate classification for the four groups. In order for the applicant to present a cogent argument relative to there being not showing of a "serious burden", he must demonstrate that the inventions are unpatentable over each other, with or without the prior art, or that the Examiner's separate classification is in error. But that has not been done in this application.

Second, a field of search is useful primarily as an indicator of burden as explicitly set out by the MPEP and is of little value in measuring the burden of search and examination. One reason for that is that "search" itself encompasses much more than a "field of search". Search is primarily a mental operation defined by what one is looking for, not by where one is looking (i.e., which patent file being searched). That is specially apparent when one considers automated patent searches using key words which will be

different inventions even though both encompass the same "field of search", the U.S. patent files.

But a second reason "field of search" is a poor measure of the burden of search and examination is even more important: "field of search ignores the second part "examination", of "search and examination". Examination involves the continued consideration of various statutory requirements as well as formal matters through the prosecution of a patent application. Generally examination of multiple inventions is more of a burden than are searches related to the multiple inventions.

However, examiner agrees to applicant's argument of Group IV, claim 20. Claim 20 shall be restricted as subcombination, and not as method claim as shown below:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 4, 5-12, 18-19, drawn to a mirror mounting apparatus comprising a mirror housing, a base, a compression element and locking device, classified in class 359, subclass 841.
- II. Claims 13-15, drawn to specific features of the mirror housing having passage therethrough, a first receiving surface and a second base surface, the mirror housing disposed between the base member and the first slide member, the aperture configured to receive the conduit and the wire, classified in class 248, subclass 478.

- III. Claims 16-17, drawn to specific way to compress the spring compression element a fastener having fifth opening, classified in class 248, subclass 484.
- IV. Claim 20, drawn to a method of assembling a rearview mirror mounting assembly having specific features of connecting the wire to an element such as electric motor wire, classified in class 359, subclass 877.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require the particulars of the subcombination as claimed for patentability such as the mirror housing having passage therethrough, a first receiving surface and a second base surface, the mirror housing disposed between the base member and the first slide member, the aperture configured to receive the conduit and the wire. The subcombination has separate utility such as the mirror housing having passage therethrough, a first receiving surface and a second base surface, the mirror housing disposed between the base member and the first slide member, the aperture configured to receive the conduit and the wire.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require the particulars of the subcombination as claimed for patentability such as specific way to compress the spring compression element a fastener having fifth opening. The subcombination has separate utility such as specific way to compress the spring compression element a fastener having fifth opening.

. Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed does not require the particulars of the subcombination as claimed for patentability such as connecting the wire to an element such as electric motor wire. The subcombination has separate utility such as connecting the wire to an element such as electric motor wire.

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

shown to be separately usable. In the instant case, invention II has separate utility such as the mirror housing having passage therethrough, a first receiving surface and a second base surface, the mirror housing disposed between the base member and the first slide member, the aperture configured to receive the conduit and the wire. See MPEP § 806.05(d).

Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as the mirror housing having passage therethrough, a first receiving surface and a second base surface, the mirror housing disposed between the base member and the first slide member, the aperture configured to receive the conduit and the wire. See MPEP § 806.05(d).

Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as connecting the wire to an element such as electric motor wire. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, III, IV, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Henry S. Judson on 1/8/04 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

CONTACT INFORMATION

Papers related to this application may be submitted to Group 2870 by facsimile transmission. Papers should be faxed to Group 2870 via the PTO Fax center located in the Crystal Plaza 4. Faxing of such papers must conform with the notice published in the official Gazette, 1096 OG 30 (November 15, 1989). The CP-4 Fax Center number is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application should be directed to M. Sikder whose telephone number is (703) 305-5471.


MOHAMMAD SIKDER
PRIMARY EXAMINER

January 11, 2004